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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,040	12/15/1999	Michelle Q. Wang Baldonado	104323	3267
7590	12/14/2005		EXAMINER	
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			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 12/14/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

DEC 14 2005

Technology Center 2100

Application Number: 09/461,040

Filing Date: December 15, 1999

Appellant(s): BALDONADO ET AL.

James A. Oliff
Gerhard W. Thielman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 29, 2005 appealing from the Office action mailed May 18, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or having a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of invention contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appeal claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is listing of the evidence relied upon in the rejection of claims under appeal:

- Eberman et al. U.S. 6,173,287 March 1998
- Schilit et al., "Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotation", April 1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Eberman et al.** (U.S. 6,173,287 – filed 03/1998) in view of **Schilit et al.** “Beyond Paper: Supporting Active Reading with Free Form Digital Ink Annotations”, published 04/1998, cited by Applicant in the IDS filed 02/07/2000.

As to independent claim 14

- a. Eberman teaches a method for associating annotations with at least one object (*e.g., an annotation of interest corresponding to the item of interest; col.2, lines 16-24*) comprising:
 - (i) searching for the at least one object to annotate (*e.g., Once the annotation of interest has been found; col.2, lines 46-59*);
 - (ii) obtaining an object identifier for at least one object (*e.g., each object in the meta database ...along with ,or with reference to, each associated object identification number; col.20, lines 61-65 /obtains the object identification number ... object type; col.21, lines 15-29*);
 - (iii) establishing a link associating the at least one annotation with the object (*col.16, lines 1-10 and Fig.7*);

- (iv) transferring the at least one annotation to the at least one object by associating the at least one annotation with the at least one object based on the link and the at least one object identifier (*e.g., the location identifier can be identified in conjunction with the locating of the annotation of interest ... the search identifier is preferably an object identifier ...the stored address identifiers are URLs identifying the locations of digital representations within one or more databases; col.3, lines 13-54 and Fig.9*).
- b. Eberman teaches generating at least one annotation using an annotation device (*e.g., The annotation client 18 ... generate annotations for the object; col.7, lines 19-34 and Fig.1A*). Also, Eberman teaches the use of a viewing device (*e.g., the user 11 to browse and/or retrieve all or a portion of a corresponding digital representation... The browser client 20 then presents the HTML results page to the user 11 so that the user 11; col.8, line 67-col.9, line 11*).
- c. Eberman, however, does not specifically teach “a viewing device that is distinct from the annotation device.”
- d. Schilit shows two clearly different devices (1) an annotation device for annotating and (2) a viewing device for viewing annotations (*see Schilit, fig.1, page 249*).
- e. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Schilit in the system of Eberman because it would have provided the capability for monitoring the free-form ink

annotations made while reading, and using these to organize and to search for material related to the annotated text (*Schilit; Abstract, page 249*).

As to dependent claim 15

Eberman teaches the annotation linking circuit establishes the link to the at least one portion based on at least one of a graphical technique and a textual technique (*col.2, lines 24-38*).

As to dependent claim 16

Eberman teaches the graphical technique associates the at least one annotation with at least one portion of the at least one object based on selection of at least one portion of a graphical icon that is a visual surrogate of the at least one object (*col.2, lines 24-38*).

As to dependent claim 17

Eberman teaches the textual technique comprises associating the at least one annotation and at least one of a word, phrase or a portion of text (*col.2, lines 24-38*).

As to dependent claim 18

Eberman teaches the textual technique is based on a phrase completion technique (*col.22, line 23-col.23, line 67*).

As to dependent claim 19

Eberman teaches associating the object identifier and the at least one object (*col.2, lines 16-45*).

As to dependent claim 20:

Eberman teaches retrieving supplemental information associated with the at least one object (*Abstract*).

As to dependent claim 21:

Eberman teaches developing a digital surrogate of the at least one object (*col.2, lines 16-45*).

As to dependent claim 22:

Eberman teaches retrieving at least one previous annotation associated with the at least one object (*col.3, lines 9-34*).

As to dependent claim 23:

Eberman teaches annotating at least one object while the annotation object is decoupled from the object (*col.7, lines 19-52*).

As to dependent claim 24

Eberman teaches searching for the at least one object comprises: entering at least one of a description of the object and the object identifier; and searching at least one of a

networked search engine, a personal computer and a distributed network (*col.2, line 24-col.3, line 34 & col.4, lines 44-65*).

As to dependent claim 25

Eberman teaches the at least one object is at least one of a media type object, a device type object, a location type object and a digital document (*col.2, lines 46-59 & figs. 8-9*).

As to independent claim 1

It is directed to a system for performing the method of claim 14, and is rejected along the same rationale. Additionally, Eberman further teaches:

- (i) a database that stores an object identifier, the at least one annotation and the link (*e.g., The search identifier and the location identifier are stored with the annotation of interest in a database; col.3, lines 9-54*); and
- (ii) a synchronize circuit that associates the at least one annotation with the at least one portion of the object based on the link and the object identifier (*see fig.9 and associated text*).

As to dependent claims 2-5

They incorporate substantially similar subject matter as in claims 15-18 above, and are rejected along the same rationale.

As to dependent claim 6

Eberman teaches the search circuit is located in at least one of the annotation device, a personal computer and a networked search engine (*col. 4, lines 44-65*).

As to dependent claim 7

Eberman teaches the search circuit receives at least one of the object identifier and one or more key words corresponding to the object to be annotated (*col.2, line 25- col.3, line 34*).

As to dependent claim 8

Eberman teaches an annotation database that stores the at least one annotation and the object identifier for the at least one object (*col.2, lines 16-45*).

As to dependent claim 9

Eberman teaches the annotation database is located on a distributed network (*see figs. 1A&1B*).

As to dependent claim 10

Eberman teaches the annotation database stores at least one annotation previously associated with the at least one object (*col.7, lines 19-67*).

As to dependent claim 11

It incorporates substantially similar subject matter as in claim 25 above, and is rejected along the same rationale.

As to dependent claim 12

- a. Eberman does not specifically teach "*the annotation device is a portable personal digital assistant, which can be decoupled from the object when the annotation is made.*"
- b. Schilit discloses the annotation device is a portable personal digital assistant, which can be decoupled from the object when the annotation is made (*page 252, left column, 1st paragraph*).
- c. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature from Schilit in the system of Eberman because it would have monitoring the free-form ink annotations made while reading, and using these to organize and to search for material related to the annotated text (*as taught by Schilit; Abstract*).

As to dependent claim 13

Eberman teaches the object identifier is collocated with the at least one object (*col.2, line 39- col.3, line 34*).

As to independent claim 26

It is directed to an information storage media for implementing the method of claim 14, and is rejected along rationale.

As to dependent claims 27-30 and 31-37

They include the same limitations as in claims 15-18 and 20-25, and are rejected along rationale.

(10) Response to Arguments

Beginning on page 8 of the brief, Appellants argue the following issues, which are accordingly addressed below.

- a. Appellants argue that Schilit fails to teach or suggest *a viewing device that is distinct from the annotation device*” (page 8).

In response, Schilit shows two clearly different devices (a) an annotation device for annotating and (b) a viewing device for viewing annotations (*see Schilit, fig.1, page 249*).

In additional support of the instant rejection, it is noted that Schilit (page 252- at upper left section “Pen Tablet Display”, 1st paragraph) describes a tablet device as both standalone, and a tablet display connected to a conventional computer, which

further suggests to the skilled artisan the distinction between a viewing device (i.e., a conventional computer monitor) and an annotation device.

- b. Appellants argue that *Eberman or Schilit do not teach an annotation system that associates annotations with at least one object, the annotation system comprising a viewing device for viewing the at least one object, the viewing device being distinct from an annotation device, a search circuit that locates the at least one object to be annotated and provides an object identifier that corresponds to the at least one object the annotation device allowing a user to make at least one annotation independently from the at least one object, the annotation device comprising an input device that inputs at least one annotation, an annotation linking circuit that establishes a link associating the at least one annotation with at least one portion of the object, a database that stores the object identifier, the at least one annotation and the link, and a synchronize circuit that associates the at least one annotation, with the at least one portion of the object based on the link and the object identifier, and wherein the user makes annotation using the annotation device while viewing the at least one object using the distinct viewing device, and upon synchronization by the synchronize circuit, the at least one annotation is transferred to the at least one object* (pages 8-9).

In response, Appellants simply point out what is recited in independent claim 1 and assert that Eberman or Schilit do not teach claim limitations. This response by

Appellants is insufficient to satisfy the requirement of specific argument to have the claim considered for patentability; in accordance with 37 C.F.R. § 1.111. Appellants must distinctly and specifically point out “how the language of the claims patentably distinguishes them from the references”. Accordingly, a *prima facie* case of obviousness is maintained as set forth in the rejections above.

- c. Appellants argue that *a prima facie case of obvious for a § 103 rejection require satisfaction of three basic criteria: there must be some suggestion or motivation either in the references or knowledge generally available to modify the references or combine reference teaching, a reasonable expectation of success, and the references must teach or suggest all the claim limitations. See MPEP § 706.02(j).* Appellants respectfully submit that the May 18, 2005 Final Office fails to satisfy these criteria based on Eberman and Schilit (pages 9-10).

In response to Appellants’ argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. See *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of

disclosures taken as a whole would suggest to one of ordinary skill in the art. See *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art rather than by their specific disclosures. The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 163 USPQ 545 (CCPA) 1969. Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. See *In re Bode*, 193 USPQ 12 (CCPA 1977). In this case, the reason for combining Eberman and Schilit is that to monitor the free-form ink annotations made while reading, and using these to organize and to search for material related to the annotated text.

- d. Appellants assert that the Examiner's interpretation of Schilit as teaching distinct devices for these functions is clearly erroneous (page 11).

In response, Schilit shows two clearly different devices (a) an annotation device for annotating and (b) a viewing device for viewing annotations (*see Schilit, fig.1, page 249*).

For the above reasons, it is believes that the rejections should be sustained.

Maikhahan Nguyen

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December 8, 2005

Respectfully submitted,

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